

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
Before the Board of Patent Appeals and Interferences

In re Patent Application of

Atty Dkt. SCS-540-551

C# M#

Confirmation No. 5875

KAYE

TC/A.U.: 3725

Serial No. 10/525,063

Examiner: T. Bonk

Filed: February 18, 2005

Date: October 20, 2008

Title: METHOD AND TOOL FOR FORMING A BRACKET IN COMPOSITE MATERIAL
AND BRACKET



Mail Stop Appeal Brief - Patents

Commissioner for Patents

P.O. Box 1450

Alexandria, VA 22313-1450

Sir:

☐ **Correspondence Address Indication Form Attached.**

☐ **NOTICE OF APPEAL**

Applicant hereby **appeals** to the Board of Patent Appeals and Interferences
from the last decision of the Examiner twice/finally rejecting
applicant's claim(s).

\$540.00 (1401)/\$270.00 (2401) \$

☐ An appeal **BRIEF** is attached in the pending appeal of the
above-identified application

\$540.00 (1402)/\$270.00 (2402) \$

☐ Credit for fees paid in prior appeal without decision on merits

-\$ ()

☒ A reply brief is attached.

(no fee)

☐ Petition is hereby made to extend the current due date so as to cover the filing date of this
paper and attachment(s)

One Month Extension \$130.00 (1251)/\$65.00 (2251)

Two Month Extensions \$490.00 (1252)/\$245.00 (2252)

Three Month Extensions \$1110.00 (1253)/\$555.00 (2253)

Four Month Extensions \$1730.00 (1254)/\$865.00 (2254) \$

☐ "Small entity" statement attached.

Less month extension previously paid on

-\$ ()

TOTAL FEE ENCLOSED \$ 0.00

☐ **CREDIT CARD PAYMENT FORM ATTACHED.**

Any future submission requiring an extension of time is hereby stated to include a petition for such time extension.
The Commissioner is hereby authorized to charge any deficiency, or credit any overpayment, in the fee(s) filed, or
asserted to be filed, or which should have been filed herewith (or with any paper hereafter filed in this application by this
firm) to our **Account No. 14-1140**.

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NIXON & VANDERHYE P.C.

By Atty: Stanley C. Spooner, Reg. No. 27,393

Signature: _____



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REPLY BRIEF

This Reply Brief is responsive to the errors, in addition to the new points of argument, raised in the Examiner's Answer. Because the Examiner does not appear to substantively dispute the conclusions in the Appeal Brief, Appellant relies upon those distinctions over the prior art for concluding that the Examiner has failed to set forth a *prima facie* case of obviousness. The discussion of the Examiner's new points of argument is as follows.

A. The Examiner errs in concluding that “the base reference, Gilb, discloses a sheet metal that is cut, bent and cured accordingly”

In the sentence bridging pages 5 and 6 of the Examiner’s Answer, the Examiner incredibly suggests that Gilb “discloses a sheet metal that is . . . cured accordingly.” As previously noted in the Appeal Brief, Gilb only discloses a “single sheet metal member” and, as is well known in the art, a metal member has no capability of being “cured.” Thus, the Examiner’s statement bridging pages 5 and 6 is simply in error and Gilb clearly does not teach “a sheet metal that is . . . cured accordingly.”

In view of the above, the observation in the Appeal Brief section A that Gilb fails to teach the sequence of steps, i.e., “cutting,” “bending” and “curing” has not been disputed by the Examiner except for his incredible statement that the metal of Gilb is “cured accordingly” and, of course, no curing of the metal in Gilb is disclosed.

Thus, and in view of the Examiner’s previous admissions that Gilb fails to teach a number of features of claim 1, Gilb clearly does not teach any curing step as suggested by the Examiner. Because the Examiner’s basis for reliance upon Gilb and a teaching in Gilb which is simply not present, Appellant’s treatment of the Examiner’s admissions in section A of the Appeal Brief is clearly accurate and apparently not disputed.

B. The Examiner fails to disclose how or where Gilb, Fogg or Machida teach the claimed elements

As noted in the Appeal Brief, Appellant’s independent claim 1 specifies the step of cutting a blank out of a sheet of composite material which has a central portion including

at least one fold line defining first and second regions of the blank. Importantly, the interrelationship between the fold line and the blank is specified as “the fold line extending only partially across the blank and creating non-folding portions of said blank at each end of the fold line” (emphasis added).

Looking at Figure 5 in the present specification, the fold line 52 can clearly be seen and this fold line defines first and second regions of the blank, i.e., regions 54 and 56. It can be seen at the left end of fold line 52 there are portions extending to the left and upwardly of region 56 which are non-folding portions of the lower and left-hand region 52. Similarly, at the right-hand end of fold line 52, there are portions extending to the right and downwardly of region 56 which are non-folding portions of the upper and right-hand region 54 .

It will be clear to those of ordinary skill in the art that no similar “non-folding portions of said blank” appear at each end of the fold line in any of the cited prior art references. For example, using the Examiner’s analogy, if seat member 9 is one region and side member 13 is the other region in Gilb’s Figure 6, there is **no non-folding portion** of seat member 9 or of side member 13 which extends beyond the fold line. Thus, Gilb cannot teach the “non-folding portion of said blank at each end of the fold line” as required by the independent claim 1.

There is no indication of any fold line nor any portion of a blank extending beyond the end of the fold line in the Machida reference. In fact, there is no actual fold line, unless it is the imaginary fold line extending into and out of the page in Machida’s Figure 3. In fact, Machida actually teaches that the fold line extends completely across any

blank taught in Machida because there is no non-folded portion illustrated in any of the drawings or discussed in the specification.

Similarly, in Fogg's Figure 7, like Gilb, there is no non-folding portion which exists at each end of the fold line. For example, if line 34 in Figure 7 of Fogg is the fold line, no non-folded portion exists beyond either end of fold line 34. The same is true with fold line 36. The same is also true with fold lines 44, 30 and 48, whether they are taken as a single long fold line or three short fold lines.

In view of the above and the Examiner's allegation that she "interprets the Gilb reference to disclose these claimed features" notwithstanding, there is simply no disclosure in any of the references. While the Examiner is free to interpret the prior art in any fanciful way she wishes, the burden on the Examiner is to show where **claimed structures** and **claimed structural interrelationships** are clearly disclosed in the prior art. The claimed structural relationships in Appellant's independent claim 1, and in particular "creating non-folding portions of said blank at each end of the fold line," are simply not identified by the Examiner as being disclosed in any prior art reference.

In attempting to support her interpretation of the Gilb reference, the Examiner alleges that lines 12, 21, 45 or 46 are fold lines defining first and second regions of the blank. As noted above, if each one of these fold lines are considered to define different regions of the blank, there is no non-folding region of the blank beyond the end of any fold line. Even the Examiner's reference to Figure 6, because it shows the central area 9 completely bounded by fold lines, effectively prevents any non-folding portion from complying with the independent claim and extending beyond the fold line.

The burden is on the Examiner to establish where there is any portion of a first region or a second region which is a non-folding portion of the blank which extends beyond a fold line. The failure to meet this burden is fatal to any *prima facie* case of obviousness, not even considering the fact that the prior art teaches away from the claimed method steps.

C. The Examiner still fails to meet her burden of providing an explicit “analysis” as required by the U.S. Supreme Court in the previously cited KSR case

The Examiner’s suggestion that the “TSM test” is the standard after the Supreme Court’s confirmation of the requirement for an explicit “analysis” is simply wishful thinking. The Supreme Court’s decision in *KSR* last year confirms the Federal Circuit *In re Rouffet* case noted in the Appeal Brief is the correct interpretation of 35 USC §103 and does not represent a deviation in the Examiner’s burden of setting out a *prima facie* case of obviousness.

Here, the Examiner has simply provided no rational reason (let alone the required “explicit” analysis) as to why one of ordinary skill in the art would combine aspects of the Gilb, Fogg and Machida references in the manner disclosed only in Appellant’s claims, especially since none of the references teach any “non-folding portions of said blank at each end of the fold line.” A *prima facie* case of obviousness is **never** made out without the Examiner first meeting her burden of showing that the claim limitations are present in **at least one** of a combination of references.

Moreover, the *prima facie* case is never made out (even if all claimed features were disclosed in at least one of a combination of references) without the Examiner identifying some **“reason” or “motivation”** for picking and choosing elements and then combining them in the manner of Appellant’s claims. Here, the Gilb reference teaches the fabrication of a metal support and the Fogg and Machida references teach the fabrication of composite components. The Examiner does not explain how or why one would take the geometry of a metal bracket and attempt to replicate it in some composite material and then magically come up with the claimed interrelationship of creating “non-folding portions of said blank at each end of the fold line” which is missing from all prior art references.

As clearly set forth in the Appeal Brief and as noted above, the Examiner has not met her burden of setting out a *prima facie* case of obviousness and any further rejection thereunder is respectfully traversed.

D. The Examiner fails to appreciate that when the prior art teaches away from the claimed invention, this is a rebuttal of any *prima facie* case of obviousness

The Examiner is reminded that the Court of Appeals for the Federal Circuit has held that “the PTO has the burden under Section 103 to establish a *prima facie* case of obviousness.” *In re Fine*, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). In this opinion, the Federal Circuit held that it is “error to find obviousness where references ‘diverge from and teach away from the invention at hand’.” *Id.* As noted above, the references all are

believed to teach solutions which do not have “non-folding portions of said blank at each end of the fold line” and these solutions teach away from the claimed invention.

As noted in section D of the Appeal Brief, Appellant notes that both the Fogg and Machida references lead those of ordinary skill in the art away from the claimed invention. Appellant corrects this argument by noting that the Gilb reference also teaches away from the “creating non-folding portions of said blank at each end of the fold line” limitation in independent claim 1. There is no non-folding portion in any of the three cited references which extends beyond the end of the fold line.

Thus, all three references suggest eliminating any non-folded portion extending beyond the fold line. For example, looking at Gilb’s Figure 6, by definition, the portion of the blank 9 which extends beyond fold line 45 is also folded and therefore cannot be a “non-folding portion.”

The Examiner also misses the mark in her argument that “one cannot show non-obviousness by attacking references individually where the rejections are based on combinations of references.” Appellant is not attacking the references because the references teach what they teach.

However, if one of the references teaches away from the claimed combination, then that one reference rebuts any *prima facie* case of obviousness, but doesn’t necessarily attack the case of obviousness itself. While Appellant has previously noted that the Examiner has not made out a *prima facie* case of obviousness, the teaching away argument is based upon the presumption, for the purposes of argument only, that the

Examiner did successfully set out a *prima facie* case of obviousness and the teaching away merely rebuts such a *prima facie* case.

So, for the purpose of the “teaching away” argument only, Appellant assumes that the Examiner has met her burden of establishing that each claim limitation is present in one or more of the combined references **and** that the Examiner has shown some explicit “analysis” of a rationale for combining portions of the references in the manner of Appellant’s independent claim. Even if a *prima facie* case is made out, Appellant is merely rebutting the *prima facie* case by pointing out that all three references actually teach away from the claimed combination of elements.

E. & F The Examiner fails to support her rejections of claims 1, 2-5 and 10 under 35 USC §103(a) over Gilb and Fogg or Gilb and Machida

In the first full paragraph on page 7 of the Examiner’s Answer, which purportedly responds to Appeal Brief sections D and E noted above, the Examiner alleges that her motivation for combining teachings of the prior art in the manner of Appellant’s independent claim (and claims dependent thereon) is because “all the references are high-strength construction connection brackets and the teaching references contain motivations to produce the claimed invention.”

The Examiner misses the point, in that the Supreme Court requirement of an explicit “analysis” is not a motivation for producing the invention of the prior art, but rather, a motivation or reason for picking and choosing elements from the separate prior art references and then combining them in the manner of the claimed invention.

Not only has the Examiner failed to demonstrate where any prior art reference teaches the claimed feature of "creating non-folding portions of said blank at each end of the fold line," but the Examiner has shown no reason to combine any features from the metal bracket of Gilb to the composite brackets of Fogg and Machida.

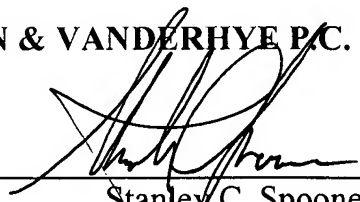
Moreover, the Examiner ignores the argument that all three references teach away from the claimed invention which has "non-folding portions of said blank at each end of the fold line" which argument rebuts any *prima facie* case of obviousness. Thus, in the Examiner's statement that the prior art references are "high-strength construction connection brackets" there is no suggestion as to how or why one would pick and choose portions of these references and then combine them in the manner disclosed only in Appellant's specification and claims.

As a result of the above, there is simply no support for the rejection of Appellant's independent claim 1 or claims dependent thereon under 35 USC §103. Appellant respectfully requests that the Board find the application is allowed on the existing claims and prosecution on the merits should be closed.

Respectfully submitted,

NIXON & VANDERHYE P.C.

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